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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/935,377	09/22/1997	MAURICE ZAUDERER	1821.0010000	8588

7590

11/19/2002

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EXAMINER

DECLoux, AMY M

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 11/19/2002

37

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/935,377

Applicant(s)

ZAUDERER, MAURICE

Examiner

Amy M. DeCloux

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-120 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-115 and 117-120 is/are rejected.
- 7) ☒ Claim(s) 116 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 04 September 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 34.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's amendment filed 9-4-02 (Paper No. 36) is acknowledged and has been entered.

In view of said amendment the outstanding 112 second paragraph rejection has been withdrawn, as has the outstanding objection to the Abstract.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

MAINTAINED Claims 68-70 and 120 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wolfel et al (US Patent 5,530,096 6-25-1996).

Response to Arguments

Applicant's arguments filed 9-4-02 have been fully considered but they are not persuasive. Applicant traverses the rejection on the grounds that the instant invention is distinct from the referenced art. Specifically Applicant contends that the method of the instant invention requires that a host cell expressing the target epitope undergoes a lytic event upon interaction with a specific cytotoxic T cell, that recovery of those host cells harboring the desired recombinant vector is made by collecting the actual cells which have undergone the lytic event, and that from those recovered cells, the nucleic acid molecule encoding the desired target epitope is isolated. Applicant contends that this method is distinct from the referenced art which teaches removing the vector from positive clones that have undergone a lytic event. This is not found persuasive because it appears that in both cases the cell are lysed and the nucleic acid encoding the epitope is recovered. Furthermore, it's not clear to the examiner how one can collect the actual cells that have undergone a lytic event, which appears to be the Applicant's basis for the difference between the instant invention and the referenced art.

Therefore, though Applicant's arguments have been carefully considered, they are not deemed persuasive, and the rejection is maintained essentially for the reasons of record.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

MAINTAINED Claims 68-111, 114-115 and 117-120 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfel et al (US Patent 5,530,096 6-25-1996) in view of Paoletti et al (US Patent 5,494,807, Feb 1996).

Response to Arguments

Applicant's arguments filed 9-4-02 have been fully considered but they are not persuasive. Applicant traverses the rejection on the grounds that a discussed above, the '096 patent fails to teach collecting the actual host cells that react with the CTL. This is not found persuasive for the reasons discussed supra. Applicant further contends that the '096 reference fails to cure the defects of the '096 patent. Since the Examiner does not agree with the putative defects of '096, as discussed supra, the rejection is maintained, essentially for the reasons of record, though Applicant's arguments have been carefully considered.

Allowable Subject Matter

Claim 116 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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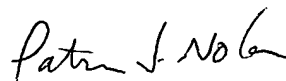
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy M. DeCloux whose telephone number is 703 306-5821. The examiner can normally be reached on M-F 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 703 308-3973. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3014 for regular communications and 703 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.

Amy DeCloux, Ph.D.
Patent Examiner
November 13, 2002


Patrick J. Nolan, Ph.D.
Primary Patent Examiner,
Group 1640